

REMARKS

Claims 1-22 are currently pending. Applicants respectfully request favorable reconsideration in view of the remarks presented herein below.

At the outset, Applicants note with appreciation the indication that claims 3, 4, 9, 11, 12, 14, 16, and 18-22 contain allowable subject matter, and would be allowed if rewritten in independent form.

In paragraph 2 of the Office Action ("Action"), the Examiner rejects claims 1, 5, 13, 15, and 17 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,806,081 to Swen et al. ("Swen"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102, the cited reference must teach each and every claimed element. In the present case, claims 1, 5, 13, 15, and 17 are not anticipated by Swen because Swen fails to disclose each and every claimed element as discussed below.

Independent claim 1 defines a method of outputting image data generated relative to a first color space by an output device that converts image data of a second color space to a visually-perceptible analog thereof. The method includes, *inter alia*, receiving from a provider, over a communication channel, original image data that was generated according to a first color space, receiving from said provider, over a communication channel along with the original image data, tag data representing parameters of the first color space, automatically converting, *in said output device*, the original image data into converted image data of the second color space, and converting the converted image data into a visually-perceptible analog thereof.

Swen discloses a method and system for embedding a device profile into a document and extracting a device profile from a document in a color management system. The method of extracting the device profile from a document includes allocating memory for a buffer, sending a ready call, reading the device profile or portions thereof from the document into the buffer and transferring the same to a file, and finally sending a complete call. Although the method may allow for the conversion of image data from a source device to be converted into a color space of an output device, nowhere in Swen is there any disclosure of the converting, *in the output device*, the original image data into said second color space according to the received tag data to produce converted image data of the said second color space as claimed. To the contrary, Swen discloses that the conversion occurs as part of the ColorSync Utilities which is known to be run outside the source or output devices, as shown in Fig. 2.

Independent claim 5 defines a method of outputting original image data generated relative to a first color space by an output device that converts image data of a second color space to a visually-perceptible analog thereof. The method includes, *inter alia*, receiving, from a provider over a communications channel, original image data generated according to a first color space, monitoring for the presence of tag data, the tag data representing parameters of a color space, over the communications channel, presuming if no tag data is received over the communications channel that said first color space is a default color space, and converting in the output device, the original image data into said second color space based upon the presumption that said first

color space is the default color space to produce converted image data of said second space.

Nowhere in Swen is there any disclosure of monitoring for the presence of tag data and presuming the first color space is a default color space if no tag data is received as claimed. Accordingly, independent claim 5 is patentable over Swen because Swen fails to disclose each and every claimed element.

Independent claims 13 and 15 define image processing systems that include, *inter alia*, an output device configured to carry out the method of claims 1 and 5, respectively. Therefore, claims 13 and 15 are patentable over Swen for at least those reasons presented above with respect to claims 1 and 5.

Claim 17 depends from independent claim 13. Therefore, claim 13 is patentable over Swen for at least those reasons presented above with respect to claim 13.

For at least those reasons presented above, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1, 5, 13, 15, and 17 under 35 U.S.C. §102.

In paragraph 4 of the Action, the Examiner rejects claims 2, 6-8, and 10 under 35 U.S.C. §103(a) as allegedly being unpatentable over Swen in view of U.S. Patent No. 6,337,922 to Kumada ("Kumada"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. §103, the Action must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the

combination must teach each and every claimed element. In the present case, claims 2, 6-8, and 10 are not rendered unpatentable over the combination of Swen and Kumada for at least the reason that the combination fails to disclose each and every claimed element as discussed below.

Claims 2, 6-8, and 10 variously depend from independent claims 1, 5, and 13. Therefore, claims 2, 6-8, and 10 are patentable over Swen for at least those reasons presented above with respect to claims 1, 5, and 13.

Kumada discloses an image processing apparatus and method for color matching in a network using a communication device which communicates with a network server storing a plurality of device profiles and color management modules. However, Kumada fails to overcome the deficiencies of Swen.

Since both Swen and Kumada both fail to disclose or suggest a method that includes automatically converting, *in the output device*, the original image data into the second color space according to the tag data as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Swen and Kumada, which Applicants do not concede, the combination would still fail to render claims 2, 6-8, and 10 unpatentable because the combination fails to disclose each and every claimed element. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2, 6-8, and 10 under 35 U.S.C. § 103(a).

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

Dated: April 18, 2007

Respectfully submitted,

By 

Michael K. Mutter

Registration No.: 29,680

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant